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921,000-008**REMARKS**

**Interview Summary** -- Applicants appreciate the Examiner's courtesy extended at the in-person interview on December 13, 2005. Independent claim 172 as filed in the October 5, 2005 Amendment was discussed. The Lynch and Joseph references were the main references discussed, with a brief discussion of Walker. The discussion centered on applicant's invention that the "first good or service" would not be provided to the perspective customer even if the first good or service "was currently available at the time of the communication". This Amendment adds such language to the claims. Further, minor amendments were made to clarify the purpose of the claim and to correct minor antecedent issues. For example, the phrase "an item constituting" was removed to more clearly describe that a good or a service is being offered. Also, the phrase "the system" was amended to more clearly define such a system as "a system". Additionally, claim 195 is cancelled.

**Summary of the Patentability of the Invention** -- Applicant respectfully submits that the art of record does not fairly teach or suggest, either alone or in combination, the claimed subject matter. **Each of Lynch, Joseph and Walker aim to supply the customer with their desired primary good or service or to come as close to the desired good or service as is possible given inventory constraints.** As will be detailed, below:

- Lynch desires to provide the user with their desired travel arrangements,
- Joseph teaches providing an alternative when the desired good or service is unavailable due to inventory constraints, and
- Walker teaches an upsell that is provided in addition to the primary good or service.

None fairly teach or suggest applicant's invention that the "first good or service" would not be provided to the perspective customer even if the first good or service "was currently available at the time of the communication ... and serv(ed) to obviate the purpose for the primary transaction".

**Identification of Support for the Claims** -- At the Examiner's request, this Supplemental Amendment includes the Remarks previously presented which establish that the Amendment does not introduce new matter, as the claims are fully supported by the original

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specification. Applicant also notes that claim 172 (in unamended form) was presented during the prosecution of the parent case (now US Patent 6,055,513).

Examples of support are provided, below. Citations are to the parent issued patent 6,055,513.

"In the preferred embodiment, the selection of the proffer of goods, services or information comprises an upsell with respect to the primary transaction or primary interaction data." (Abstract)

"The term "upsell" means an offer or provision of a good or service which is selected for offer to the customer and differs from the good or service for which the primary contact was made. The term "upsell" is not limited to the context in which a primary transaction is intended to be a sales transaction, but additionally includes the *offer of a good or service* offered in accordance with the selection criteria of the invention even if the primary transaction is not principally sales motivated, such as *where an initial contact is for service or repair purposes.*" ('513 patent, col. 13, l. 38-47).

"... if the upsell *serves to obviate the purpose for the primary transaction, such as when the primary transaction is for customer service or repair,* and the upsell is successful in providing the customer with a new product in replacement thereof, then the primary transaction need not be consummated in the manner contemplated by the user at the point of initial contact 140. Continuing with the flow of the program, at analysis block 140, the various inputs for use by the analysis system are collected, and subsequently analyzed. In the course of this collection and analysis, various sites, such as the website's own database, 144, remote database A 150 and/or remote database B 152 may be accessed. The coupling 154 between the analysis system 144 and the website database 146, as well as the couplings 156 to the external or other databases, 152, as well as any coupling 158 between the databases 146 (coupling to other databases not shown), 150, 152, may be implemented as known by those skilled in the art. The particular selection of interconnections between various components is left to selection of implementation, where the implementation merely needs to be consistent with the goals, objects and functionalities of this invention. Upon completion of the analysis at analysis

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block 144, the output of the analysis block 144 is provided to the user through action block 148. The upsell data may then be displayed on the caller's PC as an additional offer, or *in lieu* of the primary transaction." (513 patent, col. 19, ln. 32-58)

**The Substantive Patentability of the Claims as Now Presented --** While it is not Applicant's burden to establish the patentability of the claims, in the interest of expediting prosecution a detailed discussion is presented to distinguish the references from the claims.

**Lynch can no longer serve as a primary reference.** The Examiner has recognized that Lynch is deficient at least in that "Lynch does not disclose determining at least one alternative/replacement item to the prospective customer which is different from the first good or service and offering the item to the prospective customer in lieu of the first good or service." (Office Action mailed Feb. 2, 2005, page 4). Lynch seeks to provide the travel services requested subject to the constraints imposed by the employer/business and the travel agency. Lynch can no longer serve as a primary reference as it fully contemplates providing the service meeting the various "preferences". (See e.g., Lynch Abst. "The system (10) preferably uses the retrieved information to determine a travel plan that is satisfactory to the individual customer who is traveling, the business traveler customer which employs the individual, and the travel agency". Lynch clearly teaches away from Applicant's claimed invention. The use of Lynch as a primary reference is unsupportable.

**Joseph can neither serve as a primary reference nor as a secondary reference.** The factual lynch-pin for Joseph is that the first requested good or service is unavailable. The whole purpose and thrust of Joseph is then how to determine what is available in inventory that best suits the desires of the customer. Joseph acknowledges in both the Abstract and the Summary of the Invention that "if the item is unavailable, the computer determines alternative items that are available for sales." The Examiner has already recognized that Joseph attempts to find an "alternative item (that) is accepted by the customer". (Office Action of Feb. 2, 2005, page 5). Joseph simply does not correspond to the pending claims for at least the limitation that the "first good or service (is) currently available at the time of the communications".

**Walker clearly teaches that the primary transaction has been fulfilled.** Walker was cited for the teaching of upsells. Walker however clearly teaches providing an upsell product

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that is "supplementary" to the underlying product or service. (See e.g., the use of "supplemental" in the Abstract, two occurrences, line one and line 14, see also Fig. 3 where the underlying "purchase" is identified").

Beyond their substantive deficiency, there is no motivation to combine the references. As detailed, above, the references are simply deficient in appreciating the claimed invention. However, even if under some reading they did, there is simply no teaching or suggestion to combine the references. The Board of Patent Appeals and Interferences once again added to the long line of cases admonishing combining references without a teaching or suggestion in the art:

Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by an examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. (*Ex parte Gottling* (B.P.A.I. 2005)).

The references fail substantively on their own or in combination, and further fail in that there is simply no fair teaching in the art to combine them.

**Conclusion** — Applicant is firmly of the view that it's invention as claimed is not fairly taught or suggested in the art known to it. Applicant also notes that this case has been pending nearly 6 years, and the original presentation of claim 172 predates even the filing of this continuation. Applicant respectfully requests allowance of the claims, and request that if any matter remains that the undersigned be contacted by telephone to expedite allowance.

Respectfully submitted,

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